

Rule 53(b) Continuation Application
of Application No.: 08/916,173
Docket No. 0879-0273P

12. The digital camera of claim 6, wherein when said detachable memory card is inserted in said insertion slot, more than 1/3 of said detachable memory card externally extends from said digital camera.

*Art
Amend.*
13. The digital camera of claim 6, wherein said detachable memory card is mainly for attachment when the digital camera is not being used to capture images and is normally detached when the digital camera is being used to capture images. --

REMARKS

Claims 6-13 are now present in this application, claims 1-5 being canceled without prejudice or disclaimer of the subject matter therein, and new claims 7-13 being added by the present Preliminary Amendment.

The present application now includes claims, many of which were rejected during the prosecution of parent application no. 08/916,173. Hereafter, an explanation will be given as to why the previous rejections do not apply to independent claim 6 and therefore why each of claims 6-13 of the present application should be allowed.

In the parent application, independent claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wakui in view of Macko et al. Applicant believes that this rejection is incorrect and is therefore traversed, for at least the following reasons.

With regard to the Examiner's rejection, the Examiner essentially relies on the teachings of Wakui, alleging that it is notoriously well-known to have a removable

memory card conform to the standards of PCMCIA (Personal Computer Memory Card International Association) so that images captured by digital camera can be seen on a computer display; and on the teachings that Macko et al. allegedly teaches automatic transfer to a memory card once inserted into an interface.

With regard to Macko et al., the device includes a messaging peripheral 100, a PCMCIA memory-only interface 119, and an electronic information processing device 200. Even assuming arguendo that Macko et al. stated that when coupled to the electronic information processing device 200, the messaging peripheral 104 may operate to automatically deliver received messages in real time, there is still no teaching or suggestion in Macko et al. to combine its teachings with those of Wakui for at least the following reasons.

COMBINATION IMPROPER

It would not be obvious for one of ordinary skill in the art to combine the teachings of anything providing automatic transfer of images with the teachings of Wakui. Wakui is clearly directed to a camera which teaches selective transfer between an internal memory and an external memory.

Wakui clearly includes a selection switch 22 which selects between a flash memory 20 and an IC memory card 31. By including such a switch, this clearly teaches away from automatic transfer to an external memory as is claimed in claim 6 of the present application. Thus, it would not be obvious to modify Wakui to provide automatic image data transfer from a built-in memory to a detachable memory card

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upon detecting insertion of the detachable memory card as set forth in claim 6. As Wakui fails to teach or suggest such a feature, and as its teachings would be destroyed if combined with Macko et al., Applicant respectfully submits that claim 6 is allowable.

In order for a combination of references to be found to render an invention obvious, there must be some suggestion or teaching in the art that the combination be made. *Orthokinetics, Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565 (Fed. Cir. 1986); *In re Stencil*, 828 F.2d 751 (Fed. Cir. 1987). Obviousness cannot be established by primarily combining the teachings of the prior art to produce the claimed invention unless there is some teaching, suggestion, or incentive supporting the combination. *Carrella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986). There must be some reason, suggestion, or motivation found in the prior art whereby a person or ordinary skill in the field of the invention would make the combination. That knowledge cannot come from Applicants' invention itself. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). The use of hindsight to reconstruct an invention is clearly impermissible. *Uniroyal Inc. v. Rudlan-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988); *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Examiner has found no such teaching or suggestion that the combination be made and has only utilized Applicant's invention, in hindsight, as motivation for reference combination. Such use of hindsight is clearly impermissible and therefore it is respectfully requested that claim 6, and all claims dependent thereon, be allowed.

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CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 6-13 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley, Reg. No. 34,313 at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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